

Applicant: Daniel W. King
Serial No.: 10/689,137
Group Art Unit: 3635

REMARKS

The application currently stands restricted to one of the following inventions under 35 U.S.C. 121:

- I. Claims 9-12 drawn to an apparatus for continuously producing a siding panel, classified in class 29.
- II. Claims 13 drawn to a series of elongated siding panels, classified in class 52, subclass 518.

Applicant elects group I with traverse. Applicant respectfully submits that the restriction requirement is improper and should be withdrawn. Specifically, examining claims 9 and 13 would not create an undue burden and the claims are not distinct.

The Examiners contends that search creates an undue burden because the claims are separately classified and the inventions are distinct because the product claims could be made by hand tools.

As set forth in 35 U.S.C. §121, if two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. Referring to the Manual of Patent Examining Procedure (MPEP) §802.1, the term “independent” means that there is no disclosed relationship between the two or more subjects disclosed. Said another way, the two or more subjects are unconnected in design, operation, or effect. The term “distinct” means that two or more subjects as disclosed are related, for example, as combination and part thereof, process

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and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed.

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions (see MPEP §803). For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant.

Applicant respectfully rebuts the *prima facie* showing of the Examiner. Claim 9 is directed toward an apparatus for continuously producing a succession of separate elongated siding panels. Claim 13 is directed toward the series of elongated siding panels. Each of the siding panels have a series of longitudinally spaced and integrally connected separate shingle panels with a hook-shaped lower portion and an upper portion defining a mounting flange and a groove for receiving the lower portion of a vertically overlapping panel. Further, claim 13 includes limitations that are a result of being manufactured with the apparatus of claim 9. In searching for the apparatus of claim 9 to form the siding panels, an adequate search for patentability may only be achieved by searching both classifications. Therefore, the Examiner is likely going to be reviewing numerous patents in both classifications that produce articles from the apparatus for independent of which claim the Examiner is examining. Accordingly, maintaining claims

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9 and 13 in the present application and requiring the Examiner to search two classifications would not create an undue burden.

As for distinctness, the examiner must show by way of example either (A) that the apparatus as *claimed* is not an obvious apparatus for making the product and the apparatus *as claimed* can be used to make other and different products or (B) that the product *as claimed* can be made by another and materially different apparatus. The burden is on the examiner to provide an example, but the example need not be documented. If applicant either proves or provides convincing argument that the alternative example suggested by the examiner is not workable, the burden is on the examiner to suggest another viable example or withdraw the restriction requirement.

Applicant respectfully traverses the restriction requirement, specifically that the series of elongated siding panels cannot be made by hand as suggested by the Examiner. Referring to the apparatus, the apparatus includes a continuous series of rigid mold plates defining shingle cavities and undercut cavities that form the siding panel. The mold plates have vacuum passages for progressively vacuum-forming a sheet into the shingle cavities and the undercut cavities of the mold plates. A reciprocating and traveling forming plug is positioned for successively inserting into the undercut cavities for progressively forming the series of integrally connected siding panels.

Each of the siding panels have a different configuration and a different appearance than shingle panels of each of the other the siding panels. The siding panels each have

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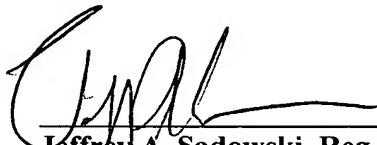
the hook-shaped lower portion having a straight edge engaging surface and a vertical distance that is the same for all of shingle panels of all of the siding panels.

Applicant respectfully submits that such a configuration of the siding panels could not be manufactured by hand. Additionally, the apparatus as claimed could not be used to make other products. Therefore, the restriction is improper and should be withdrawn.

Although no fees are believed due, the Commissioner is authorized to charge our Deposit Account No. 08-2789 for any fees or credit the account for any overpayment.

Respectfully submitted

HOWARD & HOWARD ATTORNEYS, P.C.



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Date

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